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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/021,597 | 12/12/2001 | Robert Paul Cazier | 10014023-1 | 3325 |

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| EXAMINER | |
|---|---|
| DOAN, DUYEN MY | |
| **ART UNIT** | **PAPER NUMBER** |
| 2143 | |

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/021,597 | CAZIER ET AL. | |
| | Examiner | Art Unit | |
| | Duyen M Doan | 2143 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *4/25/2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## *DETAIL ACTION*

Claims 1-19 are amended.

Claim 18 is cancelled.

Claims 20-21 are newly added.

## *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. "The auto routing system for an electronic mail system comprising computer code means for...computer code means for ....; said computer code means causing <a useful operation> to occur." Is nonstatutory, since it is not tangible embodied in a manner so as to be executable as the only hardware is in an intended use statement. This is true event if the <useful operation> includes hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware.

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (pat num 6839741) in view of Collins et al (US 2002/0013817) (hereinafter Collins)

**As regarding claim 1**, Tsai disclosed a computer network (figure 1, network 16); a server communicating over said computer network and including an undelivered data storage (figure 1, server 20); and a sender computer communicating over said computer network (figure 1, sender 12); and wherein said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage in said server (col.1, lines 55-65) and sends a notification e-mail message to the intended recipient notifying the intended recipient of the existence of the previous e-mail message, wherein the notification e-mail message includes instructing said intended recipient as to how to retrieve said least a portion of said previous e-mail message (col.3, line 1-34).

Tsai did not expressly disclose electronic mail system examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous email message.

Collins taught electronic mail system examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous email message (see Collins pg.2, paragraph 14).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the system Tsai with the teaching of Collins to examines a received e-mail message to determine whether a previous e-mail message was not received by an

intended recipient of the previous email message for the purpose of determining if recipient are unable to receive the attachment and take further action based on the determination (see Collins pg.2, paragraph 14).

**As regarding claim 2**, Tsai-Collins discloses computer network further comprises a plurality of inter-connected computer networks (see Tsai figure 1).

**As regarding claim 3**, Tsai-Freed discloses notification e-mail includes a server retrieval address comprising a hypertext markup language (HTML) address link identifying the location of said least a portion of said previous e-mail message in said undelivered data storage (see Tsai col.3, line 1-34).

**As regarding claim 4**, Tsai-Freed discloses notification e-mail includes a server retrieval address comprising a uniform resource locator (URL) address identifying the location of said least a portion of said previous e-mail message in said undelivered data storage (see Tsai col.4, line 11-26).

**As regarding claim 5**, Tsai disclosed sender computer further comprising: a sent message storage storing previously sent e-mail messages (see figure 1, sender computer 12); a received message storage storing received e-mail messages (see figure 1, sender computer 12); a server retrieval address storage storing a server retrieval address of at least a portion of a sent e-mail message posted to said server (see figure 1, sender computer 12); posts said at least a portion of said previously sent e-mail message to said server, and sends said notification e-mail message to said intended recipient (col.3, line 1-24).

Tsai did not expressly disclose a comparison rule that governs how a bounce is detected; wherein said sender computer compares a previously sent message was bounce to said previously sent e-mail messages according to said comparison rule, determines whether said received message was bounced.

Collins taught a comparison rule that governs how a bounce is detected (see pg.2, paragraph 14); wherein said sender computer compares a previously sent message was bounce to said previously sent e-mail messages according to said comparison rule, determines whether said received message was bounced (see pg.2, paragraph 14). The same motivation was utilized in claim 1 applied equally well to claim 5.

**As regarding claim 6**, Tsai-Collins disclosed sender computer receives a server retrieval address from said server after said at least a portion of said previously sent e-mail message is posted to said server, with said server retrieval address being included in said notification e-mail message (see Tsai col.6, lines 58-67 to col.7, lines 1-5).

**As regarding claim 7**, Tsai-Collins disclosed server further comprising: a sent message storage storing previously sent e-mail messages (see Tsai figure 1, server 20, with storage 22, also see Collins pg.2, paragraph 14); a received message storage storing received e-mail messages (see Tsai, figure 1, server 20, with storage 22, also see Collins pg.2, paragraph 14); sends said notification e-mail message to said intended recipient (see Tsai, col.4, line 11-26).

Tsai did not expressly disclose a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent

messages according to said comparison rule, determines whether one of said previously sent message was bounced.

Collins taught a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent messages according to said comparison rule, determines whether one of said previously sent message was bounced (see Collins pg.2, paragraph 14). The same motivation was utilized in claim 1, applied equally as well to claim 7.

**As regarding claim 8**, Tsai-Collins disclosed server transmits a server retrieval address to said intended recipient after a message bounce is detected, with said server retrieval address being included in said notification e-mail message (see Tsai col.4, line 11-26).

**As regarding claim 9**, Tsai disclosed sending a first e-mail message to an intended recipient, wherein the first e-mail message includes one or more attachment (col.3, lines 45-54). Posting at least a portion of said first e-mail message to a server accessible to the intended recipient (col.1, lines 55-65, col.3, line 1-24); and notifying said intended recipient of an availability of said at least a portion of said bounced e-mail message on said server (col.1, lines 55-65, col.3, line 1-24); wherein said intended recipient accesses said server in order to obtain said at least a portion of said bounced e-mail message (col.1, lines 55-65, col.3, line 1-24).

Tsai did not expressly disclose receiving a second e-mail message after sending the first e-mail message; determining if the size of the first e-mail message exceed a size limit, wherein the determination is based, at least in part, on information included in

the second e-mail message, in response to a determination that the size of the first e-mail message exceed a size limit.

Collins taught receiving a second e-mail message after sending the first e-mail message; determining if the size of the first e-mail message exceed a size limit, wherein the determination is based, at least in part, on information included in the second e-mail message, in response to a determination that the size of the first e-mail message exceed a size limit (see Collins, pg.2, paragraph 14).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai with the teaching of Collins to receiving a second e-mail message after sending the first e-mail message; determining if the size of the first e-mail message exceed a size limit, wherein the determination is based, at least in part, on information included in the second e-mail message, in response to a determination that the size of the first e-mail message exceed a size limit for the purpose of determining if recipient are unable to receive the attachment and take further action based on the determination (see Collins pg.2, paragraph 14).

**As regarding claim 10**, Tsai-Collins disclosed server performs the determining and notifying steps (see Tsai col.3, line 1-24).

**As regarding claim 11**, Tsai-Collins disclosed at least a portion of said first e-mail message consists of said one or more attachments (col.3, lines 1-34).

**As regarding claim 12**, Tsai-Collins disclosed sender computer performs the determining and notifying steps (see Tsai figure 1, sender communicate with recipient through non internet email 18).

**As regarding claim 13**, Tsai-Collins disclosed sending a notification e-mail message to said intended recipient (see Tsai col.3, line 18-24).

**As regarding claim 14**, Tsai-Collins disclosed the notifying step further comprising embedding an HTML address link in a notification e-mail message (see Tsai col.3, line 25-33).

**As regarding claim 15**, Tsai -Collins disclosed the notifying step further comprising embedding a URL address in a notification e-mail message (see Tsai col.4, line 11-26).

**As regarding claim 20**, the limitations are similar to claim 9, therefore rejected for the same rationale as claim 9.

**As regarding claim 21**, Tsai-Collins disclosed the second e-mail message includes a hyperlink to the file (see Tsai col.4, lines 16-22).

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (us pat 6839741) and Collins et al (US 2002/0013817) (hereinafter Collins) as applied to claim 9 above, and further in view of Freed (us 2003/0055903).

**As regarding claim 16**, Tsai and Collins disclosed every limitation of claim 9 and determining the previously sent message was bounced if a match is found (see Collins pg.2, paragraph 14), but the combination of Tsai and Collins did not expressly disclose embedding a unique identifier in each outgoing e-mail message; comparing a previously sent message unique identifier to a received message unique identifier;

Freed taught embedding a unique identifier in each outgoing e-mail message (page 2, paragraph 10); comparing a previously sent message unique identifier to a received message unique identifier (page 2, paragraph 10);

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Schneider with the teaching of Freed to have the server compare the received email message to previous email messages for the purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10-11).

**As regarding claim 17**, Tsai and Collins disclosed every limitation of claim 9 and determining that said first message was bounced if said portion match (see Collins pg.2, paragraph 14), but the combination of Tsai and Collins did not expressly disclose comparing at least a portion of said first e-mail message to a portion of said second e-mail message.

Freed taught comparing at least a portion of said first e-mail message to a portion of said second e-mail message (page 3-4, paragraph 25);

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Collins with the teaching of Freed to have the server compare the received email message to previous email messages for the purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10).

**As regarding claim 19**, the limitation is similar to claim 17, therefore rejected for the same rationale as claim 17.

## *Conclusion*

Applicant's arguments with respect to claims 1-17, 19-21 have been considered but are moot in view of the new ground(s) of rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571 272 3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
Art unit 2143

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100